

REMARKS

Applicant respectfully thanks the Examiner for the courtesy of discussing the Office Action rejections in this application during a telephone interview with the undersigned agent on August 3, 2006. During that interview, the Examiner suggested filing additional remarks which Applicant has provided below. Applicant respectfully requests withdrawal of the final rejection and reconsideration of this application in light of these additional remarks.

Claims 1-6, 8 and 21-24 stand rejected under § 103(a) as being obvious over U.S. Patent No. 5,442,500 to Hidano et al. (hereinafter referred to as "Hidano") in view of U.S. Patent No. 5,818,723 to Dimitri (hereinafter referred to as "Dimitri"). Claims 9-19, 25 and 26 stand rejected under § 103(a) as being obvious over Hidano in view of Dimitri and U.S. Patent No. 5,128,912 to Hug et al. (hereinafter referred to as "Hug"). Claims 1, 2 and 7 stand rejected under § 103(a) as being obvious over U.S. Patent No. 6,813,113 to Mueller et al. (hereinafter referred to as "Mueller") in view of Dimitri.

In brief, the present claimed invention is directed to a system for moving a data cartridge magazine between a first unit, such as an add-on unit, and a second unit, such as a magazine-based data cartridge library unit, which together comprise an expanded library. The expanded library can comprise a magazine transport device capable of moving the data cartridge magazine within the first unit, through a first passageway in the first unit and through a second passageway in the second unit, and within the second unit.

Rejections Under 35 U.S.C. § 103

Claim 1 stands rejected under § 103(a) as being unpatentable over Hidano in view of Dimitri.

Obviousness under § 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). "The factual inquiry whether to combine references must be **thorough and searching.**" *Id.* (emphasis added). In order to make out a *prima facie* case of obviousness, there must be an objective teaching in the prior art of knowledge generally

available to one of ordinary skill in the art that would lead an individual to combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The motivation may come explicitly from statements in the prior art, from knowledge of one of ordinary skill in the art, or even in the nature of the problem to be solved. *Kotzab*, at 1370. The presence or absence of motivation is a question of fact, and the evidence that motivation exists must be clear and particular. *In re Dembicza*k, 175 F.3d 994, 1000 (Fed. Cir. 1999). Further, when the references are combined, there must be a reasonable expectation of success. *In re Vaeck*, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and the prior art references must teach or suggest all the claim limitations.

Here, the Examiner has failed to carry his burden of making a *prima facie* showing that one of ordinary skill in the art would have been motivated to combine Hidano and Dimitri. According to the Examiner, the only motivation for combining Hidano with Dimitri is:

One of ordinary skill in the art would have been motivated to add the magazine transport function onto the cartridge transport device in Hidano et al.'s device, thus speed [sic, "speeding"] up the processing process.

Office Action at 3. Such a rationale is hardly "thorough and searching," especially since Hidano and Dimitri are directed entirely to solving different problems.

Hidano is directed to increasing the capacity of a storage system. Hidano purports to accomplish this by providing a "main unit 21" and optional "extension units 22." On the other hand, Dimitri is directed to increasing the speed of operation of a storage system while reducing the downtime associated with the failure of "a picker and/or transport assembly." In this regard, Dimitri teaches having magazine storage bins with "front open sides" and "back open sides," to allow for quicker access to stored media.

Even if a motivation to combine Hidano with Dimitri did exist, the combination still would fail to render obvious the subject matter of Applicant's claimed invention, as a whole and on an element-by-element basis. Combining Hidano's system with Dimitri's magazine would result, at best, in an increased capacity storage system with dual picker/transport assembly systems interacting with open-sided magazines and open-sided library frames. That combination fails to teach or suggest a "first side" or a "second side" defined by respective first and second frames, as described in Applicant's claim 1. In addition, without first and

second sides, Hidano cannot teach or suggest first and second passageways extending through the sides (in this regard, the Examiner's identification of Hidano's "guide rail 86" as a "passageway," as claimed by Applicant, is inapposite). Combining Hidano with Dimitri does nothing to remedy the failure to teach sides and passageways. As such, even if Hidano and Dimitri properly were combinable, the combination would fail to render obvious Applicant's claim 1.

Applicant reiterates from the previous response of March 13, 2006 that the Examiner has failed to substantiate the requisite *prima facie* case of obviousness because the cited references do not, neither alone nor in combination, at least teach or suggest the subject matter of Applicant's claims as a whole and all of the features of the present embodiments as recited by independent claim 1, to wit, "a first frame that defines a first side; and a first passageway extending through a portion of said first side; a second portion of said magazine-based data cartridge library comprising: a second frame that defines a second side; and a second passageway extending through a portion of said second side; a magazine transport device for moving a data cartridge magazine within said first frame, moving said data cartridge magazine through said first and second passageways, and moving said data cartridge magazine within said second frame."

The Examiner asserts that "Claim 1, Hidano et al shows a magazine-based data cartridge library in Figs. 1 and 2 including: a first portion 2a of a magazine-based data cartridge library including: a first frame 2a at left side that defines a first side; a first passageway 86 (Fig. 4; column 4, line 66) extending through a portion of the first side..." Applicant submits that Applicant's first frame is not analogous to Hidano's cartridge rack 2a. Unlike Applicant's first frame, nothing passes through Hidano's cartridge rack 2a. Hidano's cartridge rack 2a is described solely for holding cartridges that are inserted to and from the cartridge rack 2a. In Examiner's *Response to Arguments* section of the Office Action (see FIG. 2 presented with the *Response to Arguments*), the Examiner drew a plane extending beyond the limits of Hidano's cartridge rack 2a (i.e. Hidano's first frame), contending that this is a portion of a side through which a first passageway extends. The drawn plane is not a "side," as claimed by Applicant; if it were, there would be no need to add to Hidano's disclosure, as the Examiner has done here. The Examiner further incorrectly asserts that Hidano's guide rail 86 is analogous to Applicant's passageway. Applicant respectfully

submits that one of ordinary skill in the art would recognize that a guide rail is not a passageway. (For example, Webster's Encyclopedic Unabridged Dictionary of the English Language (1989) defines a "passageway" as "a way for passing into, through, or out of something, as within a building or between buildings; a hall, alley, catwalk, or the like.") And, even though the guide rail does extend into adjoining units 21 and 22, there is no mention of passageways or portions of sides through which a passageway extends in Hidano. The guide rail 86 merely breaks the 'added' plane that the Examiner drew in FIG. 2 of the *Response to Arguments*.

The Examiner further analogizes Applicant's second frame to Hidano's right side cartridge rack 2a and further analogizes a second plane extending beyond the rack 2a also drawn by the Examiner in FIG. 2 of the *Response to Arguments* to Applicant's second side through which a passageway extends through a portion thereof, "a second portion 2a of said magazine-based data cartridge library including: a second frame 2a at the right side that defines a second side; and a second passageway 86 extending through a portion of said second side..." As discussed above, the Examiner is incorrect in his analogy of Hidano's cartridge rack 2a to Applicant's frame. Furthermore, the Examiner's reliance on the second plane drawn by the Examiner is unfounded because by doing so, the Examiner is installing an element that Hidano did not teach, suggest, or based on the disclosure of Hidano, even intend. In addition, as discussed above, the Examiner incorrectly analogizes Hidano's guide rail 86 as a passageway that extends through a portion of Hidano's cartridge rack 2a.

The Examiner further asserts that "a cartridge transport device 82 for moving a data cartridge within the first frame [left cartridge rack 2a], moving a data cartridge through the first and second passageways, and moving a data cartridge within the second frame [right cartridge rack 2a]." Hidano does not move a data cartridge within either of the left cartridge rack 2a or right cartridge rack 2a, but rather Hidano moves a cartridge to and from the cartridge racks 2a.

The Examiner concedes that Hidano does not show that the transport device transports magazines, as claimed by Applicant, and that Dimitri makes up for Hidano's deficiency. The Examiner asserts that "Dimitri shows a magazine-based data cartridge library in Fig. 1, wherein a magazine transport device 110 capable of moving a data cartridge magazine among the frames." Even if Dimitri does disclose a magazine library, the Examiner's assertion that

Dimitri's library comprises two frames (see *Response to Arguments*) analogous to Applicant's two frames is incorrect. As stated by the Examiner, "Dimitri shows in Fig. 1 that the magazine transport device 110 can move magazine from first frame (the right 128) to second frame (the left 128)." Dimitri's elements 128 are rails for supporting plates 66 and are not two frames with sides through which passageways are formed.

The Examiner concludes that "One of ordinary skill in the art would have been motivated to add the magazine transport function onto the cartridge transport device in Hidano et al's device, thus speed[ing] up the processing process. In such [a] constructed device, the data cartridge magazine transport device moves [a] data cartridge magazine within the first frame, and moves data [a] cartridge magazine through the first and second passageways, and also moves [a] data cartridge magazine within the second frame." If, assuming arguendo, that one skilled in the art would be motivated to integrate a magazine transport system with Hidano's library, then what purpose would Hidano's cartridge racks 2a serve? There would in fact be no motivation by one skilled in the art to combine the references because by doing so would defeat certain key functionality in Hidano. Because there is not a bona fide showing of *prima facie* obviousness, Applicant respectfully submits that claim 1 is allowable over Hidano in view of Dimitri.

Claim 1 also stands rejected under § 103(a) as being unpatentable over Mueller in view of Dimitri.

The Examiner asserts that "Claim 1, Mueller et al shows a magazine-based data cartridge library in Fig. 2 including: a first portion (upper portion with magazines 20) of a magazine-based data cartridge library including: a first frame that defines a first side; and a first passageway 40 extending through a portion of the first side; a second portion (lower portion with magazines 20) of a magazine-based data cartridge library including: a second frame 2a at that defines a second side; and a second passageway 38 extending through a portion of the second side; a cartridge transport device 36 for moving a data cartridge magazine within the first frame, moving a data cartridge through the first and second passageways, and moving a data cartridge within the second frame."

As discussed in the previous response of March 13, 2006, the Examiner analogizes certain components in Applicant's claimed invention to Mueller but fails to clearly identify all of the elements in Applicant's claimed invention. The Examiner fails to identify the

equivalent structures or components in Mueller to Applicant's first and second frames. For example, the Examiner analogizes Mueller's top cartridge magazines 20 when disposed in an exchange drawer 16 to Applicant's first portion of a magazine-based data cartridge library but is silent to an analogy to a first frame that defines a first side. The Examiner does analogize Mueller's side portion 40 of the cartridge handling system 28 to Applicant's first passageway, hence is relying on Applicant to assume that one of the magazine 20, the drawer 16, the data storage system 12 or something else is the frame. The Examiner further analogizes Mueller's lower cartridge magazines 20 when disposed in an exchange drawer 16' to Applicant's second portion of a magazine-based data cartridge library and analogizes an element "2a" to Applicant's second frame which does not exist in Mueller's disclosure. The Examiner analogizes Mueller's side portion 38 of the cartridge handling system 28 to Applicant's second passageway, again relying on the Applicant to guess if the magazine 20, the drawer 16, the data storage system 12 or something else is the frame. Nonetheless, Mueller does not have "a magazine transport device for moving a data cartridge magazine within said first frame, moving said data cartridge magazine through said first and second passageways, and moving said data cartridge magazine within said second frame" as recited by claim 1.

In the Examiner's *Response to Arguments*, the Examiner rebuts Applicant's original arguments by writing, "Applicant argues that Mueller does not move a data cartridge or magazine within the drawer 16 and magazine 20 but rather to and from accommodating slot in the magazine. It is incorrect. Fig. 2 shows that it moves the cartridge from the drawers. If as representative argued, how can one exchange the cartridge between the drawer and the magazines[?]." The Examiner illustrates Applicant's point in his rebuttal by admitting "Fig. 2 shows that it moves the cartridge from the drawers." Mueller moves a data cartridge within his cartridge handling system 28, but only to and from his cartridge magazines 20. The cartridge is inserted to and from the magazine when in the drawer by Mueller's picker 36. The cartridge is not moved within Mueller's magazine or drawer.

The Examiner concedes that Mueller does not show that the transport device transports magazines, as claimed by Applicant, and that Dimitri makes up for Mueller's deficiency. The Examiner asserts that "Dimitri shows a magazine-based data cartridge library in Fig. 1, wherein a magazine transport device 110 capable of moving a data cartridge

magazine among the frames.” Though the Examiner is correct in that Dimitri does disclose a magazine library, the Examiner’s analogy that Dimitri’s frame comprises two frames (see *Response to Arguments*) is incorrect, as stated by the Examiner, “Dimitri shows in Fig. 1 that the magazine transport device 110 can move magazine from first frame (the right 128) to second frame (the left 128).” Dimitri’s rails 128 for supporting plates 66 are not two frames through which a passage is formed. One skilled in the art would not construct Dimitri’s library as having a first and second frame in the scope of Applicant’s claimed invention.

The Examiner concludes that “One of ordinary skill in the art would have been motivated to ad[d] the magazine transport function onto the cartridge transport device in Mueller et al’s device, thus speed up the processing process. In such constructed device, the data cartridge magazine transport device moves a data cartridge magazine within the first frame, moving a data cartridge magazine through the first and second passageways, and moving a data cartridge magazine within the second frame.” If, assuming arguendo, that one skilled in the art would be motivated to integrate a magazine transport system with Mueller’s library, Mueller’s jukebox device would not work. Hence, one of ordinary skill in the art would not have been motivated to combined the references to make Applicants claimed invention. Because there is not a bona fide showing of *prima facie* obviousness, Applicant respectfully submits that claim 1 is allowable over Mueller in view of Dimitri.

Claims 2-6, 8 and 20-24 stand rejected under § 103(a) as being unpatentable over Hidano in view of Dimitri.

Dependent claims 2-6 and 8 depend directly or indirectly from independent claim 1 which, as discussed above, is distinguishable over Hidano in view of Dimitri.

Dependent claims 20 depends directly from independent claim 1 which, as discussed above, is distinguishable over Hidano in view of Dimitri. The combination of Dimitri and Hidano still does not teach or suggest every element recited by Applicant’s independent claim 1, and therefore, cannot render obvious dependent claim 20. In addition, Applicant notes that claim 20 recites “said first portion is capable of functioning as a magazine-based data cartridge library without said second portion.” As the Examiner states in his *Response to Arguments*, “In Hidano device, the first portion (left side 2a) is capable of functioning as a magazine-based cartridge library without the second portion (right side 2a).” Applicant respectfully disagrees because Hidano’s first portion 2a (the left rack 2a) is a cartridge rack

and cannot in itself (alone) function as a library let alone a magazine based library.

Furthermore, it appears as though the Examiner is altering elements (when compared to the Examiner's earlier analysis of Hidano) by abstractly dividing the library in ambiguous ways not intended by Hidano. Because there is not a bona fide showing of *prima facie* obviousness, Applicant respectfully submits that claim 20 is allowable over Hidano in view of Dimitri.

Applicant reiterates from the previous response of March 13, 2006 that the Examiner has failed to substantiate the requisite *prima facie* case of obviousness because the cited references do not, neither alone nor in combination, at least teach or suggest all of the features of the present embodiments as recited by independent claim 21, "said cabinet comprising a first side surface that is readily alterable to form a first passageway extending through a portion of said first side surface... a magazine-based data cartridge library add-on comprising: an add-on cabinet; wherein said add-on cabinet comprising a second side surface that is either readily alterable to form or already comprises a second passageway extending through a portion of said second side surface." Nowhere does Hidano or Dimitri, at the least, teach or suggest a first or second side surface that is alterable to form a first passageway extending through a portion of said first side surface. Hence, combination of Dimitri and Hidano does not teach or suggest every element recited by Applicant's independent claim 21. Furthermore, the Examiner failed to express any motivation to combine Hidano and Dimitri for the rejection of independent claim 21 but rather simply states "the above constructed Hidano et al and Dimitri's device includes a method for making a magazine-based data cartridge library..." In the absence of express motivation, the Examiner's statement that Hidano et al and Dimitri's device includes a method for making Applicant's claimed invention is not sufficient to substantiate the motivation or suggestion required by a bona fide *prima facie* case of obviousness. *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. vs. VSI Int'l Inc.*, 50 USDPQ2d 1161 (Fed. Cir. 1999); MPEP 2143.01. Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01. In this case the Examiner has provided no evidence whatsoever that the cited references consider the combination to be desirable.

Because there is not a bona fide showing of *prima facie* obviousness, Applicant respectfully submits that claim 21 is allowable over Hidano in view of Dimitri.

Dependent claims 22-24 depend directly or indirectly from independent claim 21 which, as discussed above, is distinguishable over Hidano in view of Dimitri. The combination of Dimitri and Hidano still does not teach or suggest every element recited by Applicant's independent claim 21. Applicant thus respectfully submits that claims 22-24 are allowable.

Claims 2 and 7 stand rejected under § 103(a) as being unpatentable over Mueller in view of Dimitri.

Examiner is silent to Applicant's response to claim 2 and furthermore fails to acknowledge his obligation to provide a motivation for combining Mueller and Dimitri in regards to the unique features of claim 2 in order to sustain a *prima facie* case of obviousness to be in accordance with the law. Hence, Applicant respectfully submits that claim 2 and claim 7, which depends from claim 2, are both allowable.

Claims 9-19, 25 and 26 stand rejected under § 103(a) as being unpatentable over Hidano in view of Dimitri as applied to claim 1 and further in view of Hug.

As previously discussed in the response of March 13, 2006 dependent Claim 9 depends directly from independent claim 1 which is distinguishable over Hidano in view of Dimitri and further in view of Hug. Claim 9 recites, "said magazine transport device comprises: a first magazine transport device for moving said data cartridge magazine within said first frame; and a second magazine transport device for moving said data cartridge magazine within said second frame and within a first space that is within said first frame."

Examiner asserts in *Response to Arguments* "Hug shows in Figs 2-4 that it moves cartridges in the arrangement 12 and 14" [sic]. Examiner analogizes to Applicant's first and second frames with Hug's arrangement 12 and 14. As with Hidano and Dimitri, Hug does not teach or suggest a first magazine transport device for moving a data cartridge magazine within a first frame, rather Hug only shows a first carriage assembly 26 and a second carriage assembly 28 capable of moving disc drives and discs strictly to and from storage compartments of the arrangements 12 and 14 through "front open ends" (column 3, line 45). Even assuming, *arguendo*, that the Examiner's combination of Hidano and Dimitri and Hug is proper, and assuming that the Examiner's contention regarding the combined disclosure of

Hidano and Dimitri and Hug is accurate, the proffered combination still fails to teach or suggest each element of independent claim 1, such as a magazine transport device for moving a data cartridge magazine within a first frame and second frame that defines a first side and second side, respectively, in addition to a first and second passageway that extends through a portion of the first or second side let alone a magazine transport device that can move a data cartridge magazine through a first and second passageway, and thus cannot render dependent claim 9 obvious. Furthermore, there is no motivation to combine the references by one skilled in the art to adapt Hug's configuration to Hidano's apparatus and Dimitri's magazine transport because doing so would defeat the purpose of key features of Hidano's apparatus. Because there is no bona fide showing of prima facie obviousness for claim 9, Applicant respectfully submits that claim 9 is allowable over Hidano in view of Dimitri and in view of Hug.

Dependent claims 10-19 depend directly or indirectly from independent claim 1 which, as discussed above, are distinguishable over Hidano in view of Dimitri in view of Hug. Applicant thus respectfully submits that claims 10-19 are allowable.

Dependent claims 25 and 26 depend directly or indirectly from independent claim 21 which, as previously discussed in the response of March 13, 2006, are distinguishable over Hidano in view of Dimitri in view of Hug. Nowhere do any of the references disclose, teach or suggest features such as a first and second side surface of a library and add-on alterable to form a first and second passageway that extends through a portion of the relative side surfaces or a magazine transport device, or the equivalent thereof, located within an add-on cabinet, let alone moving a data cartridge magazine within an add-on cabinet. Furthermore, there has been no requisite explanation of motivation to combine, and hence, no bona fide showing of prima facie obviousness. Therefore, Applicant respectfully submits that claims 25 and 26 are allowable over Hidano in view of Dimitri and further in view of Hug.

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Authorization To Charge Necessary Fees

The Commissioner is hereby authorized to charge any additional necessary fees associated with this submission, or credit any overpayment, to Deposit Account No. 50-0289.

Respectfully submitted,

Dated: 8/11/06



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